



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,019	02/09/2005	Masahiko Tanikawa	TANIKAWA I	7565

1444 7590 08/09/2007
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER

UNDERDAHL, THANE E

ART UNIT	PAPER NUMBER
----------	--------------

1651

MAIL DATE	DELIVERY MODE
-----------	---------------

08/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,019

Applicant(s)

TANIKAWA ET AL.

Examiner

Thane Underdahl

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11, 12 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 12 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to the Applicant's reply received 5/25/07. Claims 1-6, 8, 11, 12, 19-24 are pending. No claims are withdrawn. Claims 7, 9-10, 13-18 are cancelled. Claims 1, 3, 8, 11 and 12 have been amended. Claims 19-24 are new. Claim 6 has been rejoined.

Response to Election Restriction Query

The Applicant requested to know why claim 6 had been withdrawn. In the original requirement of Restriction/Election page 3 stated "The applicant must elect ONE species for a physiologically active protein selected from the group consisting of: an antibody, an enzyme, a cytokine, a hormone, or a hematopoietic factor" and "If hematopoietic factor is elected as a physiologically active protein, an additional election of species must be made, selecting from the group consisting of: a erythropoietin or granulocyte colony-stimulating factor". In the response the Applicant elected a cytokine. However claim 6 will be rejoined since it is not burdensome to search these additional species.

Response to Applicant's Arguments— 35 U.S.C § 102

In the response submitted by the Applicant the 35 U.S.C § 102 (b) rejection of claims 1, 3-5, 11 and 18 based on Castle is withdrawn in light of applicant's amendment.

Response to Applicant's Arguments— 35 U.S.C § 103

In the response submitted by the Applicant the 35 U.S.C § 103 (a) rejection of claims 2 and 12 based on Castle et al. is withdrawn in light of Applicant's amendment.

In the response submitted by the Applicant the 35 U.S.C § 103 (a) rejection of claim 8 based on Castle et al. and Cohen is withdrawn in light of Applicant's amendment.

New Rejection Necessitated by Amendment

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 11, 12, 19-21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bohr et al. (U.S. Patent # 6060293).

These claims are drawn to a method of stabilizing a recombinant protein solution formulation or recombinant protein-containing solution by storing these solutions under magnetic field lines. The recombinant protein is a physiologically active protein that is isolated and purified selected from the group such as an antibody, enzyme, cytokine and hormone.

Art Unit: 1651

Furthermore the claims 19-24 are drawn to stabilizing a composition of a protein in a pharmaceutically acceptable carrier such as water. The proteins for this composition consist of antibodies, enzymes, cytokines and hormones.

Bohr et al. teach a method for stabilizing a recombinant protein solution formulation and solution that contains a recombinant proteins, antibodies as well as enzymes, peptides, and polypeptides under magnetic field lines(see Abstract and col 22, lines 60-65 and col 29, lines 42-51). These proteins are inherently physiologically active since they are used for therapeutic purposes (see Abstract). The method of Bohr et al. can be adapted to a fermentation system for bulk recombinant protein production to reduce the formation of inclusion bodies and their isolation and purification (col 20, lines 25-65 and col 2, lines 20-36). The proteins can be stored under magnetic field lines while in pharmaceutically acceptable carriers such as water (Example 5 and Example 11).

Therefore the reference anticipates claims 1, 3, 4, 11, 12, 19-21 and 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 11, 12, 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohr et al as applied to claims 1, 3, 4, 11, 12, 19-21 and 24 above

Art Unit: 1651

and in further view of rational below with support from Plantanias et al. (JCO, 1991) and further support from Rosse et al. (ASH, Hematology 2000).

While Bohr et al. does store a recombinant protein solution formulation and protein solutions in a pharmaceutically acceptable carrier he does not specifically teach the storage of recombinant hematopoietic factors such as erythropoietin and granulocyte colony-stimulating factor. Regardless this would be obvious to one of ordinary skill in the art by the time the invention was made in view of the teachings of Bohr et al. One of ordinary skill in the art would recognize that recombinant molecules such as recombinant erythropoietin (**EPO**) has been used as a therapeutic agent to treat anemia resulting from chronic renal failure and cancer chemotherapy (as supported by Platnias et al. see abstract) and sickle cell anemia (as supported by Rosse et al. page 8, col 1 paragraph 1 and page 13, col 1 paragraph 3). Since the method of Bohr et al. intends to treat numerous diseases by producing, isolating and stabilizing recombinant proteins by storing them under magnetic field lines, it would have been obvious to someone skilled in the art to produce and stabilized EPO with the method of Bohr et al. The motivation is provided by Bohr et al. who expressly desires to treat anemia and cancer (col 27, 43-59) with the proteins produced by their method. The reasonable expectation of success comes from the successful treatment of anemia with EPO.

Therefore, the invention as a whole would have been prima facie obvious at the time of filing in view of the references listed above and as such claims 1-6, 11, 12, 19-24 are not allowable.

Art Unit: 1651

Claims 1-6, 8, 11, 12, 19-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Bohr et al. as applied to claim 1-6, 11, 12, 19-24 above and in further view of Cohen et al. (U.S. Patent # 3308809).

The description and rejection of claims 1-6, 11, 12, 19-24 are listed in the 35 U.S.C § 103(a) rejection above. Claim 8 further limits the method of claim 1 by storing the protein solution formulation in a pre-filled syringe.

While Bohr et al. teach applying his method of storing a protein solution formulation to apparatus such as a Fermentor (Bohr, col 20, lines 38-67) they do not teach an apparatus such as a syringe. Regardless this would be obvious to one of ordinary skill in the art by the time the invention was made in view of the teachings of Cohen who teaches a syringe for storing blood specimens from humans in syringes. Since the method of Bohr et al. is for treating blood type diseases such as sickle cell anemia, hemophilia (Bohr col 27, lines 42-59) it would have been obvious to someone skilled in the art to store the protein solution of Bohr et al. in the syringe of Cohen since Bohr et al. intends to treat diseases with their method and syringes are an obvious tool for the administration of therapeutic agents into the body.

Therefore the references listed above renders obvious claims 1-6, 8, 11, 12, 19-24.

In summary no claims, as written, are allowed for this application.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1651

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

In response to this office action the applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP § 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 U.S.C. § 102 or 35 U.S.C. § 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is requested to provide a list of all copending U.S. applications that set forth similar subject matter to the present claims. A copy of such copending claims is requested in response to this Office action.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thane Underdahl whose telephone number is (571)

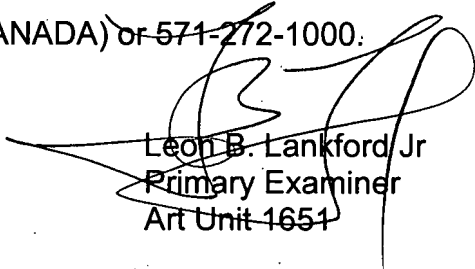
Art Unit: 1651

272-9042. The examiner can normally be reached Monday through Thursday, 8:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thane Underdahl
Art Unit 1651



Leon B. Lankford Jr
Primary Examiner
Art Unit 1651